

AMENDMENT UNDER 37 CFR § 1.111
Serial No. 09/725,921

REMARKS

A total of 70 claims remain in the present application. The foregoing amendments are presented in response to the Office Action mailed September 29, 2004, wherefore reconsideration of this application is requested.

By way of the above-noted amendments, independent claim 49 has been amended to incorporate the subject matter of original claim 53, which has been cancelled to avoid redundancy. Consequential amendment has been effected to adjust the dependency of claim 54. Clearly, no new subject matter has been introduced.

Referring now to the text of the Office Action:

- Claims 5-7, 25, 29-31, 49, 53-54 stand objected to, but not rejected;
- claims 1-4, 25-28 and 49-52 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over the teaching of United States Patent No. 6,574,201 (Kreppel) in view of United States Patent No. 6,608,832 (Forslow);
- claims 10-11, 14, 20, 34-35, 38, 57-58, 61 and 67 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over the teaching of United States Patent No. 6,574,201 (Kreppel) in view of United States Patent No. 6,608,832 (Forslow), and further in view of United States Patent No. 6,363,424 (Douglas et al); and
- claims 5-9, 12-13, 15-19, 21-24, 29-33, 36-7, 39-48, 53-56, 59-60, 62-66 and 68-71 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As an initial matter, applicant appreciates the Examiner's indication of allowable subject matter in claims 5-9, 12-13, 15-19, 21-24, 29-33, 36-7, 39-48, 53-56, 59-60, 62-66 and 68-71. The Examiner's objections to claims 5-7, 25, 29-31, 49, 53-54, and rejections under 35

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U.S.C. §103(a) are believed to be traversed by the above-noted claim amendments, and further in view of the following discussion.

Claim Objections

The Examiner has objected to claims 5-7, 25, 29-31, 49, 53-54 on the ground that these claims contain the phrase "adapted to". According to the Examiner, "It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. With respect, Applicant believes that *In re Hutchison* does not provide and *per se* rule prohibiting the term "adapted to", and that Applicant's use of the term in claims 5-7, 25, 29-31, 49, 53-54 is proper.

In particular, claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See *In re Venezia*, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

In the present case, the use of the terminology "adapted to" in claims 5-7, 25, 29-31, 49, 53-54 does not render these claims vague and indefinite, since the scope of these claims can be ascertained. The recitation that an element is "adapted to" perform a function is a limitation, which requires that the structure be able to perform the recited function. As such, the scope of the claims can be ascertained with a reasonable degree of precision and particularity. See, for example, the 2003 Decision of the Board of Patent Appeals and Interferences in Appeal No. 2003-0242, Application No. 09/484,604 (Published on the USPTO Web site at: <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd030242.pdf>). While such decisions do not constitute binding precedent on the Board, it does indicate the acceptance by the USPTO of the term "adapted to" in patent claims.

Claim Rejections Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-4, 25-28 and 49-52 as being unpatentable over the teaching of United States Patent No. 6,574,201 (Kreppel) in view of United States Patent No. 6,608,832 (Forslow).

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With respect to claims 49-52, it is believed that the Examiner's rejection is traversed by way of the above-noted amendment of claim 49 to incorporate the subject matter of allowable claim 53.

With respect to claims 1-4 and 25-28, the Examiner has asserted that these "... are method and systems claims corresponding to the apparatus claims 49-52. Therefore, claims 1-4 and 25-28 are, and as such are analyzed and rejected as previously discussed with respect to claims 49-52. Applicant respectfully disagrees.

In particular, claim 1 is a method claim that sets out method steps of steps of: at a first network element, encapsulating a functional content of a transaction message in a Protocol Data Unit (PDU) of the broadband packet network; forwarding the PDU through the broadband packet network to a second network element; and invoking the functionality using the encapsulated transaction message functional content. Claim 25 is a system claim corresponding to method claim 1, and defines the first and second network elements connected to the broadband packet network and performing the method of the invention as defined in claim 1. In contrast, claim 49 is an apparatus claim directed to a network element, which is designed to perform the functionality of the first network element of the system of claim 25 (and thus performs the first step of the method of claim 1). As such, both of claims 1 and 25 define limitations that are not included in claim 49, so reasons for rejecting claims 49-52 cannot simply be applied to claims 1-4 and 25-28.

With specific reference to claims 1 and 25, neither Kreppel nor Forslow teach or suggest a method and system in which a first network element encapsulates a functional content of a transaction message in a Protocol Data Unit (PDU) of the broadband packet network, forwarding the PDU through the broadband packet network to a second network element; and invoking the functionality using the encapsulated transaction message functional content.

Kreppel teaches a mobile radio telephone network for handling a packet data service, in which an interface Gnew is provided between an SGSN and a service control function SCF. This arrangement enables the SCF to interact with the Service Switch Function SSF (which is integrated within the SGSN) to deliver IN functionality to subscribers of the GPRS network.

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However, this functionality is delivered by interaction between the SGSN and the SCF. Kreppel does not teach or suggest that the SGSN encapsulates functional content of a transaction message within a PDU of the GPRS-N network, forwards the PDU through the network to another network element, which then invokes the transaction oriented telephony functionality using the functional content encapsulated within the PDU, all as per the present invention. Forslow fails to provide the missing teaching.

Forslow implements Intelligent network functionality in a GSM wireless network, by providing an SGSN 50 of the GSM GPRS network 51 with interfaces between a base station controller 34 and the SS7 network 40. This arrangement enables the SGSN 50 to interact with the SS7 network 40 and thereby provide services of the digital network 51, IP data network 56 and ISP 58 to the mobile station 12. However, this functionality is delivered by interaction between the SGSN 50 and the BSC 34 and SS7 network 40. Forslow does not teach or suggest that the SGSN 50 encapsulates functional content of a transaction message within a PDU of the GSM GPRS network 51, forwards the PDU through the network 51 to another SGSN of the network 51, which then invokes the functionality using the functional content encapsulated within the PDU, all as per the present invention.

Accordingly, it is believed that independent claims 1 and 25 patentably define over the teachings of the cited references. The dependent claims are believed to define further patentable features of the invention, and thus provide further grounds for patentability.

In light of the foregoing, it is respectfully submitted that the presently claimed invention is clearly distinguishable over the teaching of the cited references, taken alone or in any combination. Thus it is believed that the present application is in condition for allowance, and early action in that respect is courteously solicited.

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If any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this response, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 19-5113.

Respectfully submitted,



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